

Application Serial No.: 10/659,246
Amdt. dated December 14, 2005
Reply to Office Action of June 14, 2005

AMENDMENTS TO THE DRAWINGS

In the drawings, please replace Sheets 1/7 and 2/7 of the drawing sheets (showing Figures 1 and 2) with the enclosed "Replacement Sheets" (showing Figures 1, 1A and 2).

Application Serial No.: 10/659,246
Amdt. dated December 14, 2005
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REMARKS/ARGUMENTS

The Office Action dated June 14, 2005 and the references cited therein have been carefully considered. In response to the Office Action, Applicants have amended the drawings, and specification to address the informal objections set-forth in the Office Action. Applicants have also added new Claim 88 which, when considered with the remarks set forth below, are deemed to place the case in condition for allowance. As a result of the present Amendment, Claims 40-88 remain in the case for continued prosecution.

Drawing Objections

In the Office Action the drawings have been objected to based on various informalities. In response, Applicants submit herewith Replacement Sheets for the drawings addressing each of the Examiner's objections. In particular, Fig. 1 has now been re-numbered as two figures (Fig. 1 and Fig. 1A) and the "A-A" shown in Fig. 2 has been changed to "2A-2A." The specification has also been amended accordingly. Accordingly, it is respectfully submitted that the drawing objections have been overcome.

Specification Objections

The specification has also been objected to based on several informalities. In response, Applicants have amended the specification to address each of the Examiner's objections. In particular, Applicants have deleted or amended each paragraph in the specification making reference to a claim number. Applicants have also amended the abstract to remove legal phraseology. Accordingly, it is respectfully submitted that the specification objections have been overcome.

Application Serial No.: 10/659,246
Amdt. dated December 14, 2005
Reply to Office Action of June 14, 2005

Prior Art Claim Rejections

Further in the Office Action, Claims 40-43, 50, 52-54, 55-58, 63-71, 73-82, 85 and 87 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over PCT Publication No. WO 97/20315 to Heiligers et al., in view of U.S. Patent No. 5,868,986 to Foulkes and U.S. Patent No. 6,255,948 to Wolpert et al. Claims 44-49, 59-62 and 82-84 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Heiligers et al. in view of Foulkes and Wolpert et al. and further in view of U.S. Patent No. 4,639,341 to Hanamoto et al. Finally, Claims 51, 72 and 86 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Heiligers et al. in view of Foulkes, Wolpert et al. and further in view of U.S. Patent No. 5,815,292 to Walters and U.S. Patent No. 5,189,531 to Palmer et al.

The Examiner states that the Heiligers et al. publication discloses a method for manufacturing a storage device having a first cover pivotally connected to a second cover. The Examiner states that the Heiligers publication discloses all of the structural features of the claims but does not expressly disclose positioning an authentication means in the injection molded part. The Examiner cites the Foulkes patent as disclosing an in-mold labeling technique in which a pre-formed polymeric label is incorporated in an injection mold during molding. The Examiner further cites Wolpert as disclosing in-mold labeling of authentication devices which may be encoded with data pertaining to the item. The Examiner concludes that it would have been obvious to combine the teachings of these three references to arrive at the claimed invention.

Applicants respectfully traverse the prior art claim rejections. In particular, it is respectfully submitted that the rejections of the claims under 35 U.S.C. §103(a) are based on impermissible hindsight and should be withdrawn.

It is well settled that the teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991). *See also* MPEP §2145(X)(D)(2). Additionally, when applying 35 U.S.C. §103, the references must suggest the desirability and thus the obviousness of making the combination without the benefit of

Application Serial No.: 10/659,246
Amdt. dated December 14, 2005
Reply to Office Action of June 14, 2005

impermissible hindsight vision afforded by the claimed invention. *Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 n.5 (Fed. Cir. 1986).

Thus, it is improper hindsight merely to “pick and choose” components from the prior art references to arrive at the claimed invention. There must be a suggestion in the prior art references to combine the components as recited in the claimed invention. *See* MPEP §2141 - §2143. It is respectfully submitted that there is no suggestion in the prior art references for combining in-mold labeling with CD or DVD case manufacturing. Therefore, contrary to the Examiner’s assertion, it would not have been obvious to one skilled in the art to combine the references.

It is true that the Heiligers publication discloses a one-piece injection molded box for storing a data carrier, such as a CD or a DVD. It is also true that the Foulkes patent discloses an in-mold labeling technique. However, neither Heiligers nor Foulkes discloses using such label for in-mold labeling CD or DVD boxes, as set forth in the claimed invention. Indeed, until the filing of the present application, such process has never before been done.

Instead, today’s manufacturers of audiocassette, CD and DVD cases or boxes have heretofore strived to manufacture boxes which can be universally used and are therefore not product specific. Such identical cases are made in the billions and are only later adapted for a specific product by inserting loose leaflets, booklets, stickers or the like, which had to be added upon filling of the box with a specific product, such as a prerecorded audiocassette, disc or the like. Therefore, it has never before been contemplated to in-mold label CD or DVD boxes with labels associated directly with the CD or DVD to be placed inside the box. For these reasons a person skilled in the art would not be tempted to combine Heiligers with Foulkes. Combining these references clearly involves impermissible hindsight afforded by the present invention.

Moreover, while the cited Wolpert patent discloses the use of magnetic/metallic security tags, there is absolutely no disclosure in this reference of providing in-mold labeling data specific to a CD or DVD. Instead, the security tags disclosed in the Wolpert patent are generally used with currency, tickets, cloth labeling and the like, and can be magnetized and

Application Serial No.: 10/659,246
Amdt. dated December 14, 2005
Reply to Office Action of June 14, 2005

demagnetized at will. No disclosure whatsoever is given in Wolpert for authentication of a box in relation to a CD or DVD to be stored and shipped in said box.

Furthermore, in Wolpert, the authentication label is physically attached to the actual product itself, as opposed to the box or case in which the product is to be stored, as set forth in the claimed invention. Thus, even if a person skilled in the art would have been motivated to authenticate a box in which a CD or DVD is to be stored, instead of or in addition to the DVD or CD, and further had the idea of using tags as taught by Wolpert, the Wolpert patent only discloses a large number of possibilities of attaching such tag to a product (see column 4 lines 58 to 66). In other words, the Wolpert patent actually teaches away from attaching such label to the box, as defined in the claims of the present invention.

In addition, even if such person would be tempted to add the label to the box, instead of the article of value, he would still have to make a specific choice. No indication whatsoever is given by Wolpert that in-mold labeling would be the logical or most useful method. In view of the fact that all manufacturers of CD and DVD boxes (and their customers) until now have always chosen to use standard boxes, which are provided with identification means after filling, it would have been an illogical choice to use in-mold labeling because this has to be performed prior to packaging, rendering the boxes product specific. Also, even if such person would still have made the choice for in-mold labeling, this would lead to CD or DVD boxes being labeled identically and not necessarily product specific for the DVD or CD. This means that such person would still have to make a further specific choice.

Accordingly, it is respectfully submitted that the Examiner's conclusions are based on the benefit of impermissible hindsight vision afforded by the claimed invention. Since the problem solved by the present invention has not been recognized in any of the cited references, nor by any other prior art document or other disclosure, and since these references by themselves teach away from the present invention, it is clear that independent Claims 40, 69 and 78 patentably distinguish over the prior art.

Application Serial No.: 10/659,246
Amdt. dated December 14, 2005
Reply to Office Action of June 14, 2005

Turning to the dependent claims, it is respectfully submitted that these claims set forth patentable distinctions in addition to those contained in the independent claims. For example, dependent Claim 79 further includes the step of offering the data carrier housed in the storage device to consumers for sale. In applying the Wolpert reference to reject this claim, the Examiner incorrectly equates the box containing the data carrier with the valuable merchandise (i.e., the CD or DVD) contained within the case. As set forth above, the present Claims call for an authentication means provided on the case, as opposed to the data carrier. Accordingly, it is respectfully submitted that dependent Claim 79 patentably distinguishes over the prior art for this additional reason.

With respect to dependent Claims 53, 54 and 66, although the Examiner states that it would have been obvious to provide printing on both sides of a label, this has not been shown nor rendered obvious. Indeed, such CD or DVD cases are sold in a closed position, which would make any person skilled in the art believe that the printing on the inside would be less important. Moreover, DVD-boxes are normally made in opaque plastic, such as black plastic, as are most trays of CD-boxes. Therefore, it is not at all obvious that a person skilled in the art would think of providing printing on both sides of a label.

With further respect to dependent Claim 54, the Examiner is incorrect in his application of the Foulke patent in that the label disclosed therein is provided on the outside of the product, which would allow the printing to be seen without the necessity of the product being transparent.

With respect to dependent Claims 63 and 64, a melting index between 30 and 50 would not have been obvious for a box according to Heiligers. For a box according to Heiligers, plastics would ordinarily have been used having a different melt index. Accordingly, for these additional reasons, it is respectfully submitted that Claims 63 and 64 patentably distinguish over the prior art.

With respect to paragraph 10 of the Office Action, addressing dependent Claims 44-49, 59-62 and 82-84, the Examiner states that the Hanamoto patent discloses a method for injection molding products having a transfer of imprint using a continuous sheet. However,

Application Serial No.: 10/659,246
Amdt. dated December 14, 2005
Reply to Office Action of June 14, 2005

this is totally different from using in-mold labels which are placed directly in a mold of an injection molding apparatus, as is disclosed in these dependent claims. Therefore, combining Hanamoto with Heiligers (as modified by Foulkes, which in itself is not obvious) in view of Wolpert would still not lead a person skilled in the art toward the present invention. Indeed, as is acknowledged by the Examiner, the transfer foil used by Hanamoto burns and therefore vanishes, whereas in the present invention an in-mold label is used which entirely blends to the product injection molded against the back thereof. Therefore Hanamoto is not a method of in-mold labeling.

With respect to dependent Claims 51, 72 and 86, the Examiner argues that the use of holograms as authentication means would be obvious from Walters and/or Palmer. However, while the Walters and Palmer patents may generally disclose holograms, there is absolutely no teaching or suggestion in these references of using such holograms in a device or method according to the present invention. For explained above, a person skilled in the art would not be led to such device, and, therefore, would certainly not be led to such device using holograms for authentication of a CD-box or a DVD-box. Also, while it may be known in the art to authenticate products with, for example, a software number, such authentication means are not injection molded, nor in-mold labeled but are provided by means of a sticker or the like. Therefore, the advantages of the present invention, as set forth in dependent Claims 51, 72 and 86 have not heretofore been recognized, and, accordingly, it is respectfully submitted that these claims are patentable in their own right.

Applicants have also added new independent Claim 88, which also sets forth a method for manufacturing a storage device for a plate-shaped data carrier. The method in this case includes the steps of positioning a printer head adjacent a surface of an injection mold, providing a product specific, transfer ink printing on the mold surface with the printer head and injection molding plastic against the mold surface, wherein the ink printing is transferred from the mold to the plastic and is incorporated therein to form an authentication element. It is respectfully submitted that none of the cited references disclose direct printing of the authentication information directly on a mold surface using transfer ink and wherein

Application Serial No.: 10/659,246
Amdt. dated December 14, 2005
Reply to Office Action of June 14, 2005

the information is transferred to the part during molding. Accordingly, it is respectfully submitted that new Claim 88 is patentable over the prior art.

Accordingly, it is respectfully submitted that independent Claims 40, 69, 78 and 88, and the claims which depend therefrom, patentably distinguish over the prior art.

Conclusion

In view of the foregoing amendment and remarks, favorable consideration and allowance of the application with Claims 40-88 are respectfully solicited. If the Examiner believes that a telephone interview would assist in moving the application toward allowance, he is respectfully invited to contact the Applicants' attorney at the telephone number listed below.

Respectfully submitted,



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